

REMARKS

The Office Action dated May 28, 2008 was received and carefully reviewed.

By this response, claims 1-4 are hereby amended to clarify the invention, and not for reasons of patentability. Claims 5 and 6 are hereby canceled without prejudice or disclaimer. No claims have been added. Accordingly, claims 1-4, 7 and 8 are currently pending in this application.

Reconsideration and withdrawal of the currently pending rejections are requested for the reasons advanced in detail below.

Claim Objections

Claim 6 has been canceled, thereby rendering the objection moot. Thus, Applicants respectfully request withdrawal of the objection.

Claim Rejections - 35 U.S.C. § 102

Claims 1, 5 and 6 stand rejected under 35 U.S.C. § 102(a) as allegedly being anticipated by Nishino et al. (WO 03/064399 A1) (*Nishino*, hereinafter). Applicants respectfully traverse this rejection at least for the reasons advanced in detailed below.

As a preliminary matter, claims 5 and 6 have been canceled, thereby rendering their rejection moot.

Turning now to the remaining rejection, Applicants respectfully submit that the subject application has a claim for priority under 35 U.S.C. § 119(a)-(d) to Japanese Patent Application No. 2003-282696, having a foreign priority filing date of July 30, 2003. A certified copy of Japanese Patent Application No. 2003-282696 was filed in the subject application on January 26, 2006.

An accurate English translation of Japanese Patent Application No. 2003-282696 is being submitted concurrently herewith to comply with the requirements under 37 C.F.R. § 1.55(a)(3), thereby perfecting Applicants' claim for foreign priority to Japanese Patent Application No.

2003-282696.

The foreign priority filing date for Applicants' subject application, i.e., July 30, 2003, antedates the August 7, 2003 publication date of the *Nishino* reference (WO 03/064399 A1). Thus, since Applicants' claim to foreign priority is hereby perfected, Applicants respectfully request the withdrawal of this rejection, and the allowance of independent claim 1.

Claim Rejections - 35 U.S.C. § 103

Claims 2-4, 7 and 8 stand rejection under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Katsuyuki* et al. (JP 2002-293773) (*Katsuyuki*, hereinafter) in view of *Bakalova* et al. (*Bakalova*, hereinafter), and in further view of *Smith*, Organic Chemistry, 1st Edition (*Smith*, hereinafter). Applicants traverse this rejection at least for the reasons advanced in detailed below.

Applicants respectfully submit that present independent claims 2-4 and the claims dependent therefrom, are patently distinguishable over *Katsuyuki*, *Bakalova*, and *Smith*, since *Katsuyuki*, *Bakalova*, and *Smith*, taken either alone or in combination, fail to disclose, teach or suggest all of the features recited in the pending claims.

For example, independent claim 2-4 are directed to at least the feature of causing a reaction of the ethyl 2-amino-4,5-bis(2-methoxyethoxy)benzoate with an orthoformic ester in the presence of ammonium acetate.

Katsuyuki appears to disclose the method of manufacturing an anticancer drug (see *Katsuyuki*, e.g., the Detailed Description of the Invention, paragraph [0001]). However, Applicants respectfully submit that *Katsuyuki* is completely silent with regard to causing a reaction of the ethyl 2-amino-4,5-bis(2-methoxyethoxy)benzoate with an orthoformic ester in the presence of ammonium acetate, as recited in current independent claims 2-4.

Additionally, Applicants respectfully submit that *Bakalova* and *Smith* fail to make up for the deficiencies of *Katsuyuki*. Thus, since the prior art fails to disclose, teach or suggest all of the claimed features of the present invention, Applicants respectfully request the withdrawal of

this rejection, and the allowance of independent claims 2-4.

Dependent claims 7 and 8 are allowable at least by virtue of their dependency from one of the independent claims, but also because they are distinguishable over the prior art. Thus, Applicants respectfully request the withdrawal of this rejection, and the allowance of these claims.

Claims 1 and 5 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Mhaske et al. (*Mhaske*, hereinafter) in view of *Katsuyuki*, *Bakalova* and *Smith*. Claims 1 and 6 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Mhaske*, in view of *Katsuyuki* and in further view of Yamamoto et al. (U.S. Patent No. 4,096,144) (*Yamamoto*, hereinafter). Applicants traverse these rejections for at least the reasons advanced in detailed below.

Claims 5 and 6 have been canceled, thereby rendering their rejection moot.

Applicants respectfully submit that the *Mhaske* reference, which was used as the primary reference in the rejection of independent claim 1 under 35 U.S.C. § 103(a), has an online availability date of August 22, 2006 (see *Mhaske*, e.g., the front page of Tetrahedron report number 771). The filing date of the subject application is January 26, 2006. Therefore, since the filing date of the subject application (i.e., January 26, 2006) is earlier than the availability date of the *Mhaske* publication (i.e., August 22, 2006), Applicants respectfully submit that *Mhaske does not qualify as prior art*. Accordingly, Applicants respectfully request withdrawal of this rejection, and the allowance of independent claim 1.

In view of the foregoing, it is submitted that the present application is in condition for allowance and a notice to that effect is respectfully requested. If, however, the Examiner deems that any issue remains after considering this response, the Examiner is invited to contact the undersigned attorney to expedite the prosecution and engage in a joint effort to work out a mutually satisfactory solution.

Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby

Docket No. 740709-551
Application No. 10/565,981
Page 7 of 7

authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 19-2380. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,
NIXON PEABODY LLP

Date: October 28, 2008

/Anthony J. Canning, Reg. #62,107/
Anthony J. Canning
Registration No. 62,107

NIXON PEABODY LLP
Suite 900, 401 9th Street, N.W.
Washington, D.C. 20004-2128
(202) 585-8000